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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,975	01/31/2002	Hiroshi Yageta	NEC PF2946	9127

7590 03/09/2004

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EXAMINER	
LE, HOA VAN	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/061,975	YAGETA ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 14-25 and 1-13 with broadest independent claim 14 as the main invention is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 31 January 2002 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date —.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This application is before the examiner for consideration on the merits.

I. (1) The invention in the specification has been carefully studied.

(a) There is no new chemical ingredient or material being discovered or applied in the instant application.

(b) There is no trade name or publication of "surface treatment liquid...from Nihon Parkerizing Co., Ltd." as the sole liquid being applied on the record.

© There are multiple groups of the claims (14-25) and (1-13) but there is no evidence on the record that:

(i) there are two separately and patentably different or distinct inventions, which would require and request for separate considerations and searches. No request of such issue on the record for a proper and timely consideration.

(ii) there may not allow more than one invention to be considered and searched at the same time unless applicant provide an evidence that there is no need for a separate consideration or search for an additional invention. Generally an additional consideration or search of an additional invention is burdensome. Applicant is urged to provide a convincing evidence to the contrary.

(iii) Accordingly, broadest independent claim 14 is considered as the main invention. Others are secondary. No restriction or election of species is made. No separate consideration or search is made also. Should applicant shows or urges

otherwise in the next response to this Office Action in order for it to be considered timely, a restriction will be made for the record as shown or urged.

II. Applicant's prior art submissions have been considered.

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14 as the main invention, 15-25 and 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindert et al (4,457,790), MacFarlane et al (5,920,086) and Hatazawa et al (EP 0 996 179).

Lindert et al disclose, teach and suggest a metal surface being protected by a layer having a composition comprising a polymers being read within those as claimed, phosphate and titanium fluorine compound. Please see the whole disclosure of each of the applied reference, especially in Lindert et al col.2:5 to 6:32 and Examples 2 and 4-8. For a conventional or known use of a metal as an electrical conductive material in the art, Please see at least MacFarlane et al..., especially at figure 1 and it description. For a battery, please see Hatazawa et al,...especially the figures and their descriptions. A careful studying of the invention in the instant application unveils that no new chemical ingredient or material is discovered. The showings in the specification have been considered but is given a little to no value to overcome the above applied primary references because the compared liquids in the application is less chemical ingredients

that those as claimed and those being applied above on the record. Since the claims has not been limited a concentration of each of the requisite chemical ingredients, it would like a test to be carried out with a "surface treatment liquid" having a bout 0.000.000.001 mg/l as broadly considered for an unusual or unexpected result over those applied composition above for a patentability of the claims. In the absence of convincing evidence, the claims are not patentable. Since the above references are related to metal protective surface and metal electrical conductivity, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite the conventional or well known electrical conductive property of a metal and its use as an electrical conductor and known battery. Applicant should show or provide a convincing evidence to the contrary for the patentability of the claims.

IV. Claims 14 as the main invention, 15-25 and 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehara et al (6,059,896 which is equivalent to WO 97/04145 as submitted), MacFarlane et al (5,920,086) and Hatazawa et al (EP 0 996 179).

Ehara et al disclose, teach and suggest a metal surface being protected by a layer having a composition comprising a polymers being read within those as claimed, phosphate and titanium fluorine compound. Please see the whole disclosure of each of the applied reference, especially in Ehara et al col.3:52 to 11:4 and Examples 3, 6, 9 and 10. For a conventional or known use of a metal as an electrical conductive material in the art, Please see at least MacFarlane et al..., especially at figure 1 and it description. For a battery, please see Hatazawa et al,...especially the figures and their descriptions. A careful studying of the invention in the instant application unveils that no new chemical ingredient or material is discovered. The showings in the

specification have been considered but is given a little to no value to overcome the above applied primary references because the compared liquids in the application is less chemical ingredients that those as claimed and those being applied above on the record. Since the claims has not been limited a concentration of each of the requisite chemical ingredients, it would like a test to be carried out with a "surface treatment liquid" having a bout 0.000.000.001 mg/l as broadly considered for an unusual or unexpected result over those applied composition above for a patentability of the claims. In the absence of convincing evidence, the claims are not patentable. Since the above references are related to metal protective surface and metal electrical conductivity, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite the conventional or well known electrical conductive property of a metal and its use as an electrical conductor and known battery. Applicant should show or provide a convincing evidence to the contrary for the patentability of the claims.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone numbers of the examiner is 571- 273-1332. Since there is a newly electronic filing procedure for all initial communicating papers and all responses to an Office action, the examiner fax phone number is not for use to receive any fax in response to an Office action. Applicant is requested and required

to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

(2) mail with a central mail receiving address:

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le

HVL
03 March 2004